

REMARKS

Claims 1-38 are currently pending in the present Application.

Claims 1-3, 6-7, 17, 21, 24 and 26 stand rejected under 35 U.S.C. § 112, second paragraph as indefinite for use of the term “communications options” and for reference to wireless communications options not using wireless communications.

Rejections under 35 U.S.C. § 103(a) include:

- Claims 1-2, 17-18 21, 28-33 and 36-38 as unpatentable over U.S. Patent No. 5,825,759 to Liu (“Liu”) in view of U.S. Patent No. 6,363,323 to Jones (“Jones”) or U.S. Patent No. 5493,291 to Bruggemann (“Bruggemann”), and further in view of U.S. Patent No. 5,530,917 to Andersson, *et al.* (“Andersson”);
- Claims 3-11 and 14 as unpatentable over Liu, Jones and Bruggemann in further view of U.S. Patent No. 6,282,412 to Lyons (“Lyons”);
- Claims 12-14 as unpatentable over Liu, Jones, Bruggemann and Lyons in further view of U.S. Patent No. 6,473,602 to Bottomley (“Bottomley”);
- Claims 15 and 19 as unpatentable over Liu, Jones and Bruggemann in further view of U.S. Patent No. 6,125,278 to Wieczorek, *et al.* (“Wieczorek”);
- Claims 16 and 20 as unpatentable over Liu, Jones and Bruggemann in further view of IEEE Paper The Proper Statistical Nature of Measuring and Estimating, Dr. Wm. Lee, Airtouch Communications 1999 (“Lee Paper”);
- Claims 22-23 as unpatentable over Liu, Jones, Bruggemann and Andersson in further view of U.S. Patent No. 6,185,413 to Mueller, *et al.* (“Mueller”);

- Claims 24-27 as unpatentable over Liu in view of Mueller and Wieczorek;
- Claim 34 as unpatentable over Liu, Jones, Bruggemann and Andersson in further view of Bottomley; and
- Claim 35 as unpatentable over Liu, Jones, Bruggemann and Andersson in further view of U.S. Patent No. 6,505,046 to Baker ("Baker").

Finally, objections to the Abstract and the drawings have been entered.

The Applicant wishes to express his appreciation for the courtesies extended by the Examiner in the Interview on November 13, 2003. Consistent with the discussions in the Interview, the Applicant respectfully submits the foregoing amendments and following remarks. For the reasons set forth below, the Applicant maintains the pending claims are patentable over the cited references, and respectfully requests withdrawal of the pending rejections and allowance of claims 1-38.

1. The Abstract Has Been Amended In the Manner Requested.

The Applicant has amended the abstract to conform to the stated length requirement and to improve readability. No new matter has been entered. The Applicant respectfully requests withdrawal of the pending Abstract objection.

2. The Drawing Objection Has Been Addressed.

The Applicant respectfully requests Examiner approval of the attached red-ink amendments to the drawings to add reference numerals as requested. No new matter has been entered. In view of requested changes, the Applicant respectfully requests withdrawal of the pending drawing objection.

3. The Claims Are Sufficiently Definite Under § 112.

The Applicant respectfully traverses the pending rejection under § 112, second paragraph, of claims 1, 3, 7, 17, 21, 24, 26 as indefinite, on the grounds that the term “wireless communication options” is sufficiently defined in the specification.

For example, the Applicant at page 2 provides an express statement regarding what he means by this term: “By wireless communication options, it is meant the various wireless communication networks available, ...” Application at 2:9-13. The Applicant goes on to provide specific examples, *e.g.*, regional area wireless networks 10, wide area networks 12, metropolitan area networks 14, and local area networks 16. Application at 3:19-21; *see also* Figure 1.

In view of the Applicant’s discussion of what he means by “wireless communication options,” it is respectfully submitted that this term is adequately defined for the purposes of § 112, second paragraph. Reconsideration and withdrawal of the pending § 112 rejection is respectfully requested.

With regard to the remaining § 112, second paragraph, rejection, claims 2 and 6 stand rejected as indefinite as reciting wireless communication without use of wireless networks. The Applicant notes that claim 2, which depends from claim 1, recites that “one of the plurality of wireless communication options is not using any wireless communication.” In other words, this claim recites that one option, among the plurality of communication options, is to simply choose to not engage in wireless communication if, in accordance with the method of the

present invention, such a choice is the preferred option. The Applicant further notes that this interpretation is consistent with the teachings of the present specification (*see, e.g.*, Application at 17-18; Fig. 10 (describing use cost/speed trade-offs for determining which wireless communication option to use, where no communications available at a reasonable cost is a potential choice)), and is sufficiently definite because the alternative interpretation – the connection to a wired network assumed in the pending Office Action – is unsupported in, and inconsistent with, the teachings of the present specification.

In view of the foregoing the Applicant respectfully submits that claims 2 and 6 are sufficiently definite and respectfully request withdrawal of the pending § 112 rejection.

4. The Claims Are Patentable Over the References Under § 103(a).

The Applicant respectfully traverses the pending rejections under § 103(a) of the claims as unpatentable over Liu and the remaining cited references on the grounds that Liu does not teach or suggest all the features of the present invention for which it is cited, and these features are not taught or suggested by the remaining references.

The present invention is directed to a method by which a mobile communication device selects from a variety of available wireless communications options along its travel route to ensure optimal, seamless vertical handoff between the communication options. The predictive method provides for determining which of several available communication options should be used at various locations along a route, based on factors such as

location of the mobile communication device, the route, data on the availability of various wireless communication networks in a geographic area, amount and timeliness requirements for information transfer, the speed of the vehicle and hence the length of time it will be within range of a communication option, and cost of use of each communications option.

In contrast, Liu discusses how , *on one network*, a company could distribute its mobile services based on where it predicts its customers will ultimately be located. *See, e.g.*, Liu at 1:58-2:10; Abstract. Because Liu teaches distribution of facilities on one network (*i.e.*, a “provider-side” focus rather than teaching a “user-side” method), this reference does not teach or suggest the present invention’s predictive vertical handoff between *alternative* wireless communications options by a single mobile communications device.

For the foregoing reasons, the Applicant respectfully submits that the Liu reference fails to teach or suggest all the limitations of the present invention for which it is cited, and these limitations are not taught or suggested by any of the remaining references, either alone or in combination. Accordingly, reconsideration and withdrawal of the § 103(a) rejections of Claims 1-38 is respectfully requested.

Conclusion

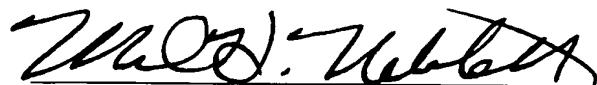
For the foregoing reasons, the Applicants believe currently pending Claims 1-38 are allowable, and the Application is in allowable form. Issuance of a Notice of Allowance for the pending claims is respectfully requested.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #225/51484US).

Respectfully submitted,

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